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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,526	12/05/2000	Eduardo Ramirez de Arellano	LOSAS-0000	7475

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 08/15/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,526

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 7/5/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) 14-20 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-13 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1762

### **DETAILED ACTION**

1. Applicant's election with traverse of claims 1-13 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that since the composition of the second group is that used in the method, the examination of all claims would not pose an undue burden on the examiner. This is not found persuasive because (1) the patentability issues associated with, and evolving as a result of, separate searches of composition and method of use claims may require issues and complex evidence unfamiliar to the examiner, and therefore poses in and of itself an undue burden since composition is an unrelated art area, and (2) the inventions have already been shown to be separate and distinct in the previous office action, the basis of which was not disputed by Applicants. MPEP 802.01 states two or more distinct inventions may not be claimed in one application. It is also noted Applicants also did not contest the grouping set forth and explained by the Examiner. The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1762

**Specification**

2. The disclosure is objected to because of the following informalities: page 3, line 4, the basis of the percentage of chloride ions is unstated; page 10, line 10, the basis of 50% of particles is unstated (e.g. percent by weight, volume, etc).

Appropriate correction is required.

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2,4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 2 is vague and indefinite because the basis of 50% of particles is unstated (e.g. percent by weight, volume, etc).

- Claim 4 is vague and indefinite because the basis (e.g. by weight, volume, etc) of the percentage of chloride ions is unstated.

Art Unit: 1762

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1-3,6-10,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishida et al US 3853577.

Nishida et al teaches a method of applying a decorative mortar-based layer onto surfaces including concrete. The coating composition comprises mixing an

Art Unit: 1762

epoxy-based mortar, cement, aggregate, water, and additives (specifically citing on column 3, 37-38 a hardening accelerator of a chlorine (halogen)-containing salt). Earlier on column 3, aggregate sizes of more than about 60 wt% of 50-200 mesh (300-75 microns) are taught, which overlaps the limitations of claim 2. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made if the overlapping portion of the size ranges disclosed by the reference were selected because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Wortheim* 191 USPQ 90. The process thus requires mixing at least powders of cement and titania pigment, per claim 8. After curing/ semi-hardening for about 0.5-6 hours, a trowel is used to flatten/ remove the raised portions of the layer to provide an aesthetic/ decorative effect, while the layer still has sufficient plasticity to be worked. A specific set time of "approximately two hours" or working the surface "after approximately two hours" is not explicitly taught. However, those times are within the range of 0.5-6 hours required for semi-hardening while maintaining plasticity to allow working of the surface to create the decorative effects. Since the reference also explicitly teaches the use of halogen salt hardening accelerators, the addition of such accelerators to cause semi-hardening/ maintaining plasticity within a desired

Art Unit: 1762

time frame would have been an obvious variation within the purview of one of ordinary skill. The skilled artisan would have been motivated to minimize/optimize time to cause semi-hardening/ maintaining plasticity to optimize process efficiency and maximizing the amount of work completed within a given workday (dependant on hours of daylight, weather, etc). A similar rationale is equally valid for the times of independent claim 7.

Since column 4, 48-55 suggests using tools other than a roller or flat trowel to surface the coating to form a decorative effect, use of a conventional alternative such as a "rough" trowel would have been an obvious variation to provide additional aesthetic/ decorative effects in the semi-hardened, plastic coating in accordance with claims 6 and 12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Nishida et al and utilize sufficient chloride salt accelerator to provide semi-hardening and plasticity of the coating within a desired time frame prior to working the decorative surface in order to maximize process efficiency.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishida et al US 3853577 in view of Admitted prior Art (APA) of pages 1-3 "Background".

Art Unit: 1762

Nishida et al is cited for the same reasons discussed above, which are incorporated herein. While the amount of chloride ions, per claim 4, is not cited, it is the Examiner's position that the accelerator would have been diluted in a suitable solvent (water) in an amount to achieve a desired hardening time. Alternatively, one of ordinary skill would have utilized a commercially available chloride accelerator, such as the BETTACEL disclosed in the background, containing about 25% chloride ions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Nishida et al by substituting the calcium chloride accelerator for a commercially available chloride accelerator such as BETTACEL disclosed in the APA because of the expectation of achieving equivalent results.

9. Claims 5, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishida et al US 3853577 in view of Lurie US 2035172

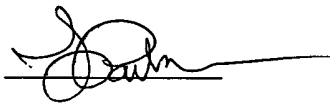
Nishida et al is cited for the same reasons discussed above, which are incorporated herein. Application by trowel is not cited. However, Lurie teaches on column 2, 28-35 to apply cementitious materials to exteriors of walls by trowel, spraying, etc. Since Nishida et al sprays a similar material onto a wall, and Lurie teaches the equivalence of applying such materials onto walls by



Art Unit: 1762

spraying, trowel, etc, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nishida et al by applying the layer by a trowel instead of a spray gun in accordance with the equivalence taught by Lurie prior to the semi-hardening and treating steps because of the expectation of forming a similar decorative layer.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred J. Parker whose telephone number is (703) 308-3474.



Fred J. Parker

**FRED J. PARKER  
PRIMARY EXAMINER**

August 14, 2002

9-730526